



UNITED STATES PATENT AND TRADEMARK OFFICE

cl
UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/669,424	09/24/2003	Frank Berendes	CH-7929/LeA 36,206	5072

34947 7590 10/13/2006

LANXESS CORPORATION
111 RIDC PARK WEST DRIVE
PITTSBURGH, PA 15275-1112

EXAMINER

RAHMANI, NILOOFAR

ART UNIT	PAPER NUMBER
----------	--------------

1625

DATE MAILED: 10/13/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/669,424

Applicant(s)

BERENDES ET AL.

Examiner

Niloofer Rahmani

Art Unit

1625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 August 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 10-16, 19 and 20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 10-16, 19 and 20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____.

DETAILED ACTION

1. Claims 10-16, and 19-20 are pending and claims 1-9, and 17-18 are cancelled.

2. *Priority*

This application is filed on 09/24/2003, which claims the priority of GERMANY 10244811.6, filed on 09/26/2002.

3. The rejection of claims 1-16 under 35 U.S.C. 103(a) over WO 2004/024708 is withdrawn in view of the applicant's argument.

4. The rejection of claims 10-16, and 19-20 under 35 U.S.C. 112, first paragraph for "W being CN" is withdrawn in view of the applicant's argument.

5. The rejection of claims 10-16, and 19-20 under 35 U.S.C. 112, second paragraph for the term "convert" is maintained for reason of record. Applicants argue that the term "converting" would be readily understood by any person having ordinary skill in the art, and, therefore, the use of the term is not confusing. Second, clause (c) expressly states that the conversion of formula (IV) to formula (VI) is "by reduction," and, therefore, the step of "converting by reduction" is, in fact, recited. Finally, clause (a) claims the conversion of formula I to formula II, and, thus, such step is not, in fact, missing. It is the examiner's position that there are no steps to convert formula (IV) to formula (VI). Further, essential steps such as converting from formula I to II are missing.

6. The rejection of claims 10-16, and 19-20 under 35 U.S.C. 112, first paragraph for the term "6-10 ring atoms" is maintained for reason of record. Applicants argue that examples of species meeting this definition are set forth at page 6, lines 18-19, namely indolyl, indazolyl, benzofuranyl, benzothiophenyl, quinolonyl or isoquinoliny. Further, the presence or absence of working examples is only one factor to be taken into consideration in determination enablement. It is the examiner's position that the specification, while being enabling for 6-membered rings, does not reasonably provide enablement for 7-10 membered rings. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to 7-10 membered rings the invention commensurate in scope with these claims. There is no example in the specification for 7-10 membered rings. All the examples are for 6-membered rings.

THIS ACTION IS MADE FINAL. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.


7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Niloofar Rahmani whose telephone number is 571-272-4329. The examiner can normally be reached on Monday through Friday from 8:30 am to 5:00 pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas Mckenzie, can be reached on 571-272-0670. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

NILOOFAR RAHMANI

10/02 /2006

NR


MARGARET D. SEAMAN
PRIMARY EXAMINER
GROUP 1625